

U.S. Application No.: 09/995,217 Examiner: P.C. Wilder Art Unit: 2623
Amendment in Response to October 5, 2006 Office Action

Docket: BS0094139

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REMARKS

In response to the Office Action dated October 5, 2006, Assignee respectfully requests reconsideration based on the amendments and remarks set forth herein. Assignee respectfully submits that all pending claims are in condition for allowance.

Claims 1-31 are pending. Claims 1, 11, 21, 25, 26, 29, 30 and 31 are amended. Support for the amendments may be found in the Specification at paragraphs [0010], [0024], [0027], [0029], and [0031]-[0034], for example. No new matter is submitted. Accordingly, entry and consideration of the amendments are respectfully requested.

Extension of Time

This response includes a petition for an extension of time in which to respond to an office action. The Assignee respectfully petitions the Commissioner for a two month extension of time from January 5, 2007 to February 5, 2007. The Commissioner is respectfully requested charge the 37 C.F.R. § 1.17 (a) (2) large entity fee of \$450.

35 U.S.C. § 102 (b) Rejection

In the Office Action, claim 21 is under 35 U.S.C. § 102 (e) as allegedly anticipated by U.S. Patent No. 65,880,768 to Lemmons, *et al.* (hereafter "*Lemmons*"). The rejection is respectfully traversed.

A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, *Lemmons* fails to include every element of the pending claims. *Lemmons*, thus,

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does not anticipate the features recited in claim 21. Accordingly, the Assignee respectfully requests that the Office remove the 35 U.S.C. § 102 (b) rejection of claim 21.

Independent claim 21 is set forth in full above and generally recites a method for generating programming guides. More particularly, claim 21 recites generating programming guides comprising, *inter alia*, “*storing preliminary channel information, from at least one of tuner activities of a user and other external sources, in a memory of a receiver.*” The user may thus supplement any programming guide information provided from an external source in order to initially generate a working programming guide according to claim 21. See, Specification at paragraphs [0032], for example. Further, the external sources described in the Specification may include preloaded channel information in the receiver from the vendor or manufacturer of the receiver (Specification at paragraph [0029]), or host computers or web sites associated with broadcast stations, or other entities that provide programming information (Specification at paragraph [0027]).

Lemmons does not teach or disclose the combination of features recited in claim 21, because *Lemmons* does not teach, disclose or suggest a method of generating programming guides comprising, *inter alia*, “*storing preliminary channel information, from at least one of tuner activities of a user and other external sources, in a memory of a receiver.*”

The Office Action is correct to the extent that *Lemmons* discloses an interactive program guide system and method for automatically tuning a television or VCR. U.S. Patent No. 5,880,768 to Lemmons, *et al.* (March 9, 1999) at column 4, lines 1-6. *Lemmons*, however, explains that a set-top box is used to receive program schedule information from a headend telecasting center 54 in order to generate the initial programming guide. *Id.* at Abstract and column 4, lines 8-20. Moreover, *Lemmons* explains that a headend computer 64 at the telecast center generates the initial program information schedule for eventual transmission to a user's set-top box 70. *Id.* at column 6, lines 37 -50. The program schedule information includes program titles, telecast times, channels, program descriptions, and other useful information. *Id.* at column 4, lines 8-20. *Lemmons* thus requires that preliminary programming information stored in the memory of a receiver, i.e., the set-top box, is generated from a headend computer 64

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at the headend telecast center 54. In this regard, *Lemmons* further explains that the program schedule information is first received by the tuning circuitry 72 of the set-top box 70 via transmission from the telecast center 54 on a cable network 68. *Id.* at column 7, lines 9-13. The initial loading of program schedule information in *Lemmons* is thus limited to generation by selections of a headend computer 64 transmitted to a tuner, i.e., set-top box 70, via a cable network 68. *Lemmons* thus does not teach or disclose the storing of preliminary information "from at least one of tuner activities of a user and other external sources, in a memory of a receiver" as recited in pending claim 21. *Lemmons* thus fails to provide the combination of features recited in claim 21. Assignee therefore respectfully requests that the 35 U.S.C. §102(b) rejection of claim 21 be removed.

35 U.S.C. § 103 (a) Rejections

In the Office Action, claims 1, 5-7, 9-11, 14-17, 19 and 31 are rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over *Lemmons* in view of U.S. Patent No. 6,934,917 to Lin (hereafter "Lin"); claims 2, 4, 12 and 13 are rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over *Lemmons* in view of *Lin* and U.S. Patent Application Publication No. 2003/0056216 to Wogofski, *et al.* (hereafter "Wogofski"); claim 23 is rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Lemmons* in view of *Wogofski*; claims 8, 18 and 25 are rejected under 35 U.S.C. §103(a) allegedly unpatentable over *Lemmons* in view of *Lin* and U.S. Patent No. 5,798,785 to Hendricks, *et al.* (hereafter "Hendricks"); claim 22 is rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over *Lemmons* in view of U.S. Patent No. 6,756,997 to Ward III, *et al.* (hereafter "Ward"); claim 29 is rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over *Lemmons* in view of U.S. Patent No. 5,822,123 to Davis, *et al* (hereafter "Davis") and U.S. Patent No. 6,990,676 to Proehl, *et al.* (hereafter "Proehl"); claim 3 is rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over *Lemmons* in view of *Lin*, *Wogofski* and *Davis*; claim 24 is rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over *Lemmons* in view of *Davis*; claim 20 is rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over *Lemmons* in view of *Lin* and *Davis*; claims 26, 27 and 30 are rejected under 35 U.S.C. § 103 (a)

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as allegedly unpatentable over *Lemmons* in view of *Proehl*; and claim 28 is rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over *Lemmons* in view of *Proehl* and *Lin*.

For the following reasons, however, these rejections are respectfully traversed.

1. *Lemmons* “Teaches Away” and Cannot Support a *Prima Facie* Case of Obviousness

Lemmons “teaches away” from the pending claims. A reference that ‘teaches away’ from the claimed invention is a significant factor when determining obviousness. See MPEP at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at §2143.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.* 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). “It is improper to combine references where the references teach away from their combination.” MPEP at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. See MPEP at §2143.01.

Pending independent claims 1, 11, 21, 25, 26, 29, 30 and 31 are generally directed to a broadcast signals receiver and method of using such a receiver to generate programming guides. More particularly, independent claim 1 recites, *inter alia*, a microcomputer of the receiver is adapted to “store preliminary channel information, from at least one of tuner activities of a user and other external sources, in a memory of a receiver.” Independent claims 11, 21, 25, 26, 29, 30 and 31 recite similar features.

As explained above, *Lemmons* discloses an interactive program guide system and method for automatically tuning a television or VCR. U.S. Patent No. 5,880,768 to Lemmons, *et al.* (March 9, 1999) at column 4, lines 1-6. *Lemmons*, however, explains that a set-top box is used to receive program schedule information from a headend telecasting center 54 in order to generate the initial programming guide. *Id.* at Abstract and column 4, lines 8-20. Moreover, *Lemmons* explains that a headend computer 64 at the telecast center generates the initial program

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information schedule for eventual transmission to a user's set-top box 70. *Id.* at column 6, lines 37 -50. In this regard, *Lemmons* further explains that the program schedule information is first received by the tuning circuitry 72 of the set-top box 70 via transmission from the telecast center 54 on a cable network 68. *Id.* at column 7, lines 9-13. The initial loading of program schedule information in *Lemmons* is thus limited to generation by selections of a headend computer 64 transmitted to a tuner, i.e., set-top box 70, via a cable network 68. *Lemmons* thus requires features to operate, i.e., the initial generation of program schedule information from the headend computer at a headend telecast center, which the pending independent claims do not require.

To modify *Lemmons* to establish an initial programming guide "*from at least one of tuner activities of a user and other external sources, in a memory of a receiver*" as recited in each of the pending independent claims, would thus alter the principle of operation of the system and method of *Lemmons*. The Office's *prima facie* case, therefore, requires a change to the principle of operation of *Lemmons*. The patent laws, however, forbid such changes to support an obviousness rejection. *Lemmons* thus teaches away from the pending claims and cannot be used to support a *prima facie* case of obviousness in combination with any of the other references. All remaining claims depend from one of the pending independent claims. Accordingly, withdrawal of the 35 U.S.C. § 103 (a) rejections of claims 1-20 and 22-31 based on any combination including *Lemmons* is respectfully requested.

2. Because No Reasonable Expectation of Success was Cited, the *Prima Facie* Case Is Defective

The Examiner's alleged *prima facie* case based on a combination of *Lemmons* with any of *Lin*, *Wogofski*, *Hendricks*, *Davis*, *Ward* and/or *Proehl*, is defective. A *prima facie* case for obviousness must include "a reasonable expectation of success". MPEP at §2143. Here, however, no basis was cited in the Office Action for successfully combining *Lemmons* with any *Lin*, *Wogofski*, *Hendricks*, *Davis*, *Ward* and/or *Proehl* to provide the combination of features recited in at least each of the pending independent claims, including storing preliminary channel information, "*from at least one of tuner activities of a user and other external sources, in a memory of a receiver*." All other claims ultimately depend from one of the pending independent

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claims. Because the Office has failed to make such a finding, a *prima facie* case for obviousness has not been established. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejections of claims 1-20 and 22-31 based on the combination of *Lemmons* with any of *Lin*, *Wogofski*, *Hendricks*, *Davis*, *Ward* and/or *Proehl* is respectfully requested.

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CONCLUSION

Assignee submits that all rejections to date have been overcome upon entry and consideration of this Amendment. Further, none of the references cited by the Office, alone or in combination disclose or suggest the claimed subject matter. Therefore, Assignee respectfully solicits a Notice of Allowance for all pending claims.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or scott@wzpatents.com.

Respectfully submitted,



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